

**Response to First Office Action:**

The first office action was mailed on March 10, 2005. The following are remarks directed to the restriction and rejection of the claims in the office action.

**Election/Restrictions**

Examiner required a restriction to one of the following inventions:

- I. Claims 18 and 19, drawn to the method of playing a card game, classified in class 273, subclass 292.
- II. Claims 1-17, drawn to a pack of playing cards, classified in class 273, subclass 304.

The examiner stated that the inventions are distinct because inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. The examiner alleges that the restriction is valid because the pack of playing cards can be used to play Blackjack or Poker.

Applicant respectfully requests that the examiner reconsider his restriction. Claims 1-17 are to an apparatus, a pack of playing cards, comprising cards having indicia in judicious placement to lessen both precision of vertical columnar alignment and columnar length over that obtainable with a previously known pack of playing cards. Claims 18 and 19 are to methods of playing card games requiring at least some cards placed in a column formation wherein the columns both occupy less vertical displacement and require less precise vertical alignment when compared with cards previously known. Applicant alleges that method claims are restricted to games having columns and the apparatus is designed to benefit games having columns. Thus the methods as claimed cannot be used by another materially different apparatus and the apparatus as claimed cannot be used to practice another and materially different method. The apparatus can be used to play other materially different methods of play but the benefits of the apparatus would not be realized.

For the reasons stated above, applicant respectfully requests that the examiner withdraw the restriction requirement. However, if the examiner does not withdraw the restriction requirement, applicant accepts the election of group 2 with traverse and asks the examiner to cancel claim 18 and 19.

### **102(b) Rejection by Jannersten, US D350,781**

Claims 1-6, 8-10 and 12-17 under 35 U.S.C. 102(b) were rejected as being anticipated by Jannersten. A supportable rejection under 35 U.S.C. 102(b) requires that one reference shows all elements of the rejected claims.

Examiner states that Jannersten “discloses a pack of playing cards having all of the features recited in claims 1-6, 8-10 and 12-17. The first indicia (numerical value) and the second indicia (suit) are clearly placed at the primary corners, secondary corners, top edge, bottom edge, left edge and right edge as recited in the claims. Note, Fig. 3 illustrates that the first indicia and second indicia are judiciously placed to lessen both precision of vertical columnar alignment and columnar length.”

Applicant respectfully disagrees. Claim 1 states that the invention is “a pack of playing cards comprising cards having indicia in judicious placement to lessen both precision of vertical columnar alignment and columnar length **over that obtainable with a previously known pack of playing cards (bold for emphasis)**. Jannersten does not offer any improvement in the effort to lessen precision or length over that disclosed in Fig 1B of the application because the second indicia is **vertically** aligned and not horizontally aligned with the first indicia. The structure that is further described in Claim 2 requires second indicia horizontally proximate to first indicia within a region that extends horizontally along the top or bottom edges from just outside the primary corners to a point midway between the primary and secondary corners.

Alternatively, where the playing cards have a familiar appearance through use of a graphic to denote both value and suit of each card, wherein the graphic is centrally located on each face and wherein the graphic is a grouping if a Spot Card or a picture if a Face Card, then the second indicia can be more removed from the first indicia along a horizontal alignment. Specifically, “the second indicia second indicia being in at least a first position and a second position on the

faces of the cards, the second indicia in the first position having a right-reading orientation and being in a region bordering the top edge and **extending to the right of the right-reading first indicia but not within a region proximate to the secondary corner formed by the top edge and the right edge**, and the second indicia in the second position having a upside-down-reading orientation and being in a region bordering the bottom edge and extending to the left of the upside-down-reading first indicia but not within a region proximate to the secondary corner formed by the bottom edge and the left edge.”

As shown in Fig. 1A and further illustrated in the figure enclosed with the attached Rule 132 petition, these alternative positions of the second indicia both allow columns of cards to be of less length and of less precise alignment than obtainable with previously known packs of playing cards, examples illustrated by Jannersten, in Fig. 1B of the applicant’s application, and in the first and third column of the picture enclosed with the Rule 132 petition.

The applicant respectfully asks that this rejection be withdrawn for claims 1-6, 8-10 and 12-17.

**103(a) Rejection by Jannersten US D350,781 in view of Friedman US D458,647**

Claims 7 and 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Jannersten in view of Friedman. For an obviousness rejection to stand under 35 U.S.C. 103(a) the cited references must teach or suggest all elements of the claimed invention and there must be a motivation to combine the references.

Examiner states that Friedman “teaches that it is known in the playing card art to enlarge the indicia on the edges of the playing card. Note, the title of Friedman is ‘...High Visibility Playing Cards.’ In view of such teaching it would have been obvious to a person having ordinary skill in the art to enlarge the first indicia and second indicia on the edges of Jannersten’s playing cards in order to make the indicia more visible to players with impaired vision.”

Applicant respectfully holds that this rejection is not proper. Enlarged indicia in the corners are also disclosed in the picture enclosed with the enclosed Rule 132 Petition. Cards known to the playing card art with enlarged corner-placed indicia are shown in the third right-most column of the picture. By comparison, an embodiment of the invention with enlarged indicia is shown in

the middle column. Neither Jannersten nor Friedman teach or suggest the placement of second indicia horizontally aligned with first indicia in a region to reduce column length and reduce needed precision of alignment over what is known. The position of the second indicia is further described and claimed to be horizontally proximate to first indicia or alternatively within a region that extends horizontally along the top or bottom edges from just outside the primary corners to a point proximate the region of the secondary corners when faces also have common graphics in a center region.

Similarly, Hofman (US D178,662), Nielsen (US D134,179), Roberts (US D147,815) and Stauff (US D181,884), cited by examiner as relevant but not relied upon, does not teach or suggest what applicant claims. Hofman teaches only face cards with unique center-positioned graphics, first indicia indicating values of only V, J, D, and second (suit) indicia horizontally proximate to first (value) indicia but **larger** than first indicia. Nielsen teaches four different value cards with first (value) indicia in corners but second indicia not horizontally proximate but **below the horizontal region** and **larger** than corner-positioned first indicia. The fifth card had no discernible primary or secondary indicia in or near corner regions of the face of the card. Roberts teaches four different value cards having value indicia of J, Q, K and A, first (suit) indicia in primary corners and secondary (value) indicia perpendicularly proximate to first indicia not horizontally proximate. Staff teaches playing cards with unique uncommon center graphics on the face cards, first indicia in primary corners and secondary not horizontally proximate to first indicia but horizontally displaced to a point midway between primary and secondary corners. None of these disclosures teach or suggest the placement of second indicia horizontally proximate to, and having a height that is equal to or less than, first indicia, or in a horizontally displaced region if cards have common center graphics, to reduce column length and reduce needed precision of alignment over what is known.

Since the cited references do not disclose all of the elements of the claims, Applicant respectfully requests that this rejection be withdrawn for Claim 7 and 11.

### Conclusions

Because of the above amendments and remarks, Applicant respectfully requests that the present application be allowed. Should Examiner consider that any minor matters remain prior to issuance of a Notice of Allowance, the Examiner is requested to telephone the undersigned to reach prompt resolution thereof.

Customer Number 44977

CERTIFICATE UNDER 37C.F.R. 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450 on this 8th day of June 2005.

Respectfully submitted,



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